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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,519	07/03/2001	Dale Francis Obeshaw	DP-300393	7536

7590 09/15/2003

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/898,519

Applicant(s)

OBESHAW, DALE FRANCIS

Examiner

John J. Zimmerman

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/27/03 (RCE papers).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## THIRD OFFICE ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 27, 2003 has been entered.

### *Amendments*

2. This Office Action is in response to the Amendment and Request for Reconsideration received June 23, 2003. Entry of the amendment was requested in the RCE papers submitted on August 27, 2003. Claims 1-39 are pending in this application.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,586,110. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent and the claims of this application both claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of the patent specify that the intermediate section is honeycomb structure and the claims of this application do not limit the ribbed structure to honeycomb structures, the claims of this application cover honeycomb structure intermediate layers and therefore there is no patentable distinction between the intermediate layers. [It should be noted that the claims of this application (e.g. claims 16, 18-20) also specifically claim that the ribbed structure is a "honeycomb core".] Although it is noted that the claims of this application now recite "a structural component", each section of the contoured structural members of the claims of the patent and the claims of this application qualify as a "structural component" and therefore there is no patentable distinction in this limitation.

5. Claims 1-39 are provisionally rejected under the judicially created doctrine of double patenting over the pending claims of copending Application No. 09/900,762. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the claims of both applications claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of this application now recite "a structural component", each section of the contoured structural members of the claims of both applications qualify as a "structural component" and therefore there is no patentable distinction in this limitation. In any event, some claims (e.g. claim 17) of the copending application specify further structural components. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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7. Claims 1-2, 5, 6-7, 10-13, 15, 17, 21-24, 31, 33 and 36-39 are rejected under 35

U.S.C. 102(b) as being anticipated by Layte (U.S. Patent 2,816,665).

8. Layte discloses a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section (any of the plurality of inner layers of the article shown in Figure 5) and an outer section (any of the plurality of outer layers of the article shown in Figure 5) and further having and an intermediate section of a ribbed structure (any of the intermediate layers shown in Figure 5). Although it is noted that Layte's inner and outer sections also contain rib structures, the pending claims do not prohibit rib structures in the inner and outer sections. While it is noted that Layte's article is formed from a single wound sheet, the pending claims do not prohibit forming the inner, outer and intermediate sections from single long sheets. Layte shows a further "structural component" attached to the article in Figures 7 (end caps) and Figure 8. Regarding claims reciting an "initiator", any discontinuity in the article (e.g. the holes, ribs, etc. . .) may function as an initiator. Layte forms his structural member by rolling the sections about a mandrel (e.g. see column 2, lines 43-54). Regarding article claims reciting method steps, Layte may not disclose the same process steps, but these claims are product claims and not process claims. When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Particularly note that in article claims 38 and 39 reciting a method wherein the shrink wrap is added *and* removed, the shrink wrap would not be present in the claimed final article.

***Response to Arguments***

9. Applicant's arguments filed June 23, 2003 have been fully considered but they are not persuasive with regards to the remaining rejections. Claims 1-2, 5, 6-7, 10-13, 15, 17, 21-24, 31, 33 and 36-39 are now rejected under 35 U.S.C. 102(b) as being anticipated by Layte (U.S. Patent 2,816,665). The Layte reference was uncovered in a subsequent search of the claims of this application and is particularly relevant in that it is an article made by winding a sheet of ribbed material about a mandrel. While the article of Layte is wound from a single sheet, the pending claims do not prohibit forming the inner, outer and intermediate sections from a single sheet.

10. Regarding the rejection of claims 1-39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,586,110, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent and the claims of this application both claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of the patent specify that the intermediate section is honeycomb structure and the claims of this application do not limit the ribbed structure to honeycomb structures, the claims of this application cover honeycomb structure intermediate layers and therefore there is no patentable distinction between the intermediate layers. Although it is noted that the claims of this application now recite "a structural component", each section of the contoured structural members of the claims of the patent and the claims of this application

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qualify as a "structural component" and therefore there is no patentable distinction in this limitation.

11. Regarding the rejection of claims 1-39 under the judicially created doctrine of double patenting over the pending claims of copending Application No. 09/900,762, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both applications claim a contoured structural member having a continuous plurality of contoured metal-containing layers in an inner section and an outer section and further having and an intermediate section of a ribbed structure. Although it is noted that the claims of this application now recite "a structural component", each section of the contoured structural members of the claims of both applications qualify as a "structural component" and therefore there is no patentable distinction in this limitation. In any event, some claims (e.g. claim 17) of the copending application specify further structural components.

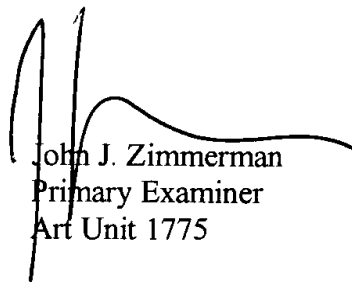
### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (703) 308-2512. The examiner can normally be reached on 8:30am-5:00pm, M-F. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



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John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
September 3, 2003